APPENDIX.

Opinion.

Chesebrough-Pond's, Inc., a corporation, Plaintiff-counterdefendant-appellee, v. Faberge, Incorporated, a corporation, Defendant-counterclaimant-appellant. No. 80-5117.

United States Court of Appeals, Ninth Circuit.

Argued and Submitted Oct. 7, 1981. Decided Jan. 22, 1982.

Plaintiff brought suit against a competitor in the men's toiletries and cosmetics industry seeking a declaratory judgment that its trademark "Match" was not so similar to competitor's trademark "Macho" that its use constituted trademark infringement or unfair competition. The United States District Court for the Central District of California, William P. Gray, J., granted summary judgment in favor of plaintiff and dismissed competitor's counterclaim for infringement and unfair competition, and competitor appealed. The Court of Appeals, Hug, Circuit Judge, held that trademark "Match" was not so similar to a competitor's trademark "Macho" that its use constituted trademark infringement or unfair competition.

Affirmed.

William K. Rieber, Los Angeles, Cal., argued, for defendant-counterclaimant-appellant; William G. Anderson, Fulwider, Patton, Rieber, Lee & Utecht, Los Angeles, Cal., Richard Whiting, Davis, Hoxie, Faithfull & Hapgood, New York City, on brief.

Richard A. Wallen, Harris, Kern, Wallen & Tinsley, Los Angeles, Cal., for plaintiff-counterdefendant-appellee.

Appeal from the United States District Court for the Central District of California.

Before HUG, FARRIS and BOOCHEVER, Circuit Judges.

HUG, Circuit Judge:

This is an action for declaratory and injunctive relief, brought by Chesebrough-Pond's, Inc. ("Chesebrough") against Faberge, Inc. ("Faberge"). Chesebrough sought a declaratory judgment that its trademark "Match" is not so similar to Faberge's trademark "Macho" that its use constitutes trademark infringement or unfair competition. Chesebrough also sought an injunction to preclude Faberge from interfering with its use of the trademark. Faberge filed a counterclaim for trademark infringement. On a motion for summary judgment, the district court entered the declaratory judgment and injunction sought by Chesebrough and dismissed Faberge's counterclaim for infringement and unfair competition.

The issues presented in this appeal are: (1) whether a justiciable controversy existed; and (2) whether a genuine issue of fact existed as to the likelihood of confusion of the trademarks.

I
FACTS

In February, 1975, Chesebrough filed an application to register its trademark, "Match," for a line of men's toiletries and cosmetics. It began developing the product line, investigating marketing, and creating packaging and advertising. Chesebrough's initial investment in development was approximately $650,000.00.

In June, 1975, Faberge acquired the "Macho" trademark, which had been registered by its prior owner in February, 1973. This mark also covered a line of men's toiletries and cosmetics. Faberge has marketed products under the "Macho" mark.

After receiving notice of the pending registration of "Match," Faberge sent Chesebrough a letter on August 25, 1975, stating that it believed the two marks to be "confusingly similar," and that unless Chesebrough withdrew its application, Faberge would file opposition thereto. When Chesebrough refused, Faberge did file an opposition proceeding in the Patent and Trademark Office. It was alleged that the " 'Match' mark so resembles opposer's mark 'Macho' as to be likely . . . to cause confusion, mistake and deception." Chesebrough filed an answer and a petition to cancel the "Macho" mark. The administrative action continued for three years, but remained in the discovery stage.

In October, 1978, Chesebrough filed this action in the district court seeking a declaratory judgment that use of "Match" would not infringe upon Faberge's rights in "Macho." Faberge counterclaimed for infringement and unfair competition and an injunction to prevent Chesebrough from using the term "Match." On Chesebrough's motion for summary judgment, the district court granted Chesebrough its requested declaratory and injunctive relief and entered judgment against Faberge on its counterclaim. It held that a substantial controversy existed between the parties "stemming from [Faberge's] letter of August 25, 1975." It found no likelihood of confusion of the two marks, and concluded that Chesebrough has the right to use the trademark "Match" insofar as the word itself is concerned, free from interference by Faberge.[1]

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[1]The district court judgment states in part:

> 5. Chesebrough has the right to use, in connection with cosmetics, toiletries, and related products, the trademark "Match," insofar as the word itself is concerned, free from interference from Faberge, its officers, its agents, servants, employees, attorneys, privies, representatives, successors, and assigns, and any and all persons acting in concert or in participation with them, whether separately or jointly, in and throughout the United States its territories and possessions or in any foreign country where the ac-

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Faberge appealed on the basis that the case does not present a justiciable controversy. It also argued that even if the case was properly before the district court, the grant of summary judgment was error because factual disputes exist as to consumer practices and perceptions, marketing of products bearing the marks, and the parties' intent.

II

Existence of an Actual Controversy

A. *Standard*

Before this court, Faberge argued that any potential threat of an infringement action is not sufficiently ripe to satisfy the case or controversy requirement, which limits declaratory judgment jurisdiction. It relied upon *Merrick v. Sharp & Dohme, Inc.*, 185 F.2d 713 (7th Cir. 1950), *cert. denied*, 340 U.S. 954, 71 S.Ct. 573, 95 L.Ed. 687 (1951),

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tivities of Faberge or Chesebrough have a substantial effect on interstate commerce or any commerce which Congress may lawfully regulate.

6. Faberge, its officers, agents, servants, attorneys, privies, representatives, successors, and assigns, and any and all other persons acting in concert or participation with them, either separately or jointly, are hereby permanently enjoined from:

a. interfering with, or threatening to interfere with the use of the trademark "Match" by Chesebrough, its related companies, successors, or assigns, in connection with its or their business in and throughout the United States its territories and possessions or in any foreign country where the activities of Faberge or Chesebrough have a substantial effect on interstate commerce or any commerce which Congress may lawfully regulate;

b. instituting or prosecuting any suit or other proceeding, placing in issue the right of Chesebrough or said related companies, successors, or assigns, to register or use the mark "Match" in connection with cosmetics, toiletries, and related products in and throughout the United States its territories and possessions or in any foreign country where the activities of Faberge or Chesebrough have a substantial effect on interstate commerce or any commerce which Congress may lawfully regulate.

The district court also stated that:

[n]o finding is made by the Court respecting the possibility of confusion arising in the event plaintiff should adopt a trade dress for its "Match" products similar to that of Faberge.

which held that the filing of a notice of opposition to registration with the Patent and Trademark Office is not equivalent to a charge of infringement. This reliance on *Merrick* is misplaced, for we view that case as inconsistent with the approach to declaratory judgments adopted by this circuit in *Societe de Conditionnement v. Hunter Engineering Co.*, 655 F.2d 938 (9th Cir. 1981).

The Declaratory Judgment Act, 28 U.S.C. § 2201, allows this court to consider cases in which an "actual controversy" exists. In *Societe* we considered under what circumstances a trademark or patent dispute ripened into an actual controversy. We held that the requirements of the Declaratory Judgment Act were satisfied "if the plaintiff has a real and reasonable apprehension that he will be subject to liability . . . ." *Id.* at 944. In applying this standard, we focused upon the position and perceptions of the plaintiff, declining to identify specific acts or intentions of the defendant that would automatically constitute a threat of litigation. The acts of the defendant were instead to be examined in view of their likely impact on competition and the risks imposed upon the plaintiff, to determine if the threat perceived by the plaintiff were real and reasonable.

Societe thus requires a flexible approach that is oriented to the reasonable perceptions of the plaintiff. The *Merrick* test, which offers a set rule under which the defendant's actions determine the existence of an actual controversy, does not fit with this analysis.[2]

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[2]Several recent authorities have questioned the vitality of the *Merrick* decision. *See Continental Connector Corp. v. Continental Specialties Corp.*, 413 F.Supp. 1347 (D.Conn. 1976); A. Greenbaum, *The Thirty-Second Year of Administration of the Lanham Trademark Act of 1946*, 69 Trademark Reporter 517, 603-04 (1979). The sources reason that the precedential value of *Merrick* is limited because it relied upon *Postum Cereal Co. v. California Fig Nut Co.*, 272 U.S. 693, 47 S.Ct. 284, 71 L.Ed. 478 (1927). *Postum* held that an opposition proceeding before the Patent and Trademark Office did not present a "case" under Article III. In *Brenner v. Manson*, 383 U.S. 519, 86 S.Ct. 1033, 16 L.Ed.2d 69 (1966), the application of *Postum* was restricted to the statutory scheme in existence prior to 1929. Arguably, *Brenner* also

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Faberge warns that a rejection of *Merrick* will cause the district courts to be burdened with unlimited and redundant requests for declaratory judgments based on imagined threats of infringement actions. We see no such danger. Declaratory relief is available at the discretion of the district court. 28 U.S.C. § 2201; *Geni-Chlor International, Inc. v. Multisonics Development Corp.*, 580 F.2d 981, 985 (9th Cir. 1978). Exercise of that discretion will allow rejection of cases that are properly before the Patent and Trademark Office. In addition, as our application of the *Societe* standard to these facts will make clear, a simple opposition proceeding in the Patent and Trademark Office generally will not raise a real and reasonable apprehension of suit.

B. *Application*

The letter sent by Faberge to Chesebrough declaring its intent to file opposition proceedings, stated a prima facie case for trademark infringement, as outlined in 15 U.S.C. § 1114(1). It alleged Faberge's ownership of a registered mark and Chesebrough's use in commerce of a mark so similar to Faberge's that it was likely to cause confusion. The "likelihood of confusion" standard is relevant to both registration and infringement proceedings. 1 McCarthy, *Trademarks and Unfair Competition*, ¶ 20:4 (1973). It was reasonable to infer from Faberge's letter a threat of an infringement action. Faberge did not act to dispel such an inference. It did not disclaim an intent to pursue an infringement action, but, in fact, responded to Chesebrough's complaint with a counterclaim seeking damages for infringement. The actual filing of a counterclaim for infringement bolsters Chesebrough's claim that a real threat existed. See *Societe*, 655 F.2d at 945.

The inference that Chesebrough drew from Faberge's actions was also reasonable in view of the business rela-

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undermines *Merrick*, but the Seventh Circuit adheres to the rule. *See James Burrough Ltd. v. Sign of Beefeater, Inc.*, 572 F.2d 574, 578 n.5 (7th Cir. 1978).

tionship of the parties. The market for men's cosmetics is expanding and highly competitive. The practical effect of the attenuated opposition proceeding before the Patent and Trademark Office was to allow expanded marketing of the "Macho" line, while chilling Chesebrough's efforts to market "Match" products. The threat that the action would move from the Patent and Trademark Office to the district court apparently was real enough to dissuade Chesebrough from further use of its mark, although it had made substantial investments in development and preliminary advertising of the line. Furthermore, a decision of the Patent and Trademark Office allowing the registration of Chesebrough's trademark would not preclude a subsequent infringement action or be determinative of the issues involved. *Carter-Wallace, Inc. v. Procter & Gamble Company*, 434 F.2d 794, 802 (9th Cir. 1970). *See also Driving Force, Inc. v. Manpower, Inc.*, 498 F.Supp. 21, 25-26 (E.D.Pa. 1980). Failure of this court to resolve the dispute would force Chesebrough to choose between continuing to forego competition in this quickly expanding market, and entering the market, risking substantial future damages and harm to relationships with its customers and retailers.

We therefore conclude that although there was no actual threat by Faberge that it would sue Chesebrough for trademark infringement, Chesebrough had a real and reasonable apprehension that such action would be taken. The district court correctly concluded that this case presented an actual controversy.

III

Existence of Factual Issues

A. *Similarity of the Marks*

Faberge contends that the entry of summary judgment was improper because of the existence of a genuine issue of fact. It challenges the district court's conclusion that the

two marks are so "dissimilar in connotation and impact" that no factual dispute exists as to their similarity. It is contended that the affidavit of Dr. Einbond, an associate professor of English, was sufficient to raise a factual dispute on this issue.

The district court based its conclusion on the comparative appearance, sound, and meaning of the two marks. *See AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 351 (9th Cir. 1979); *Carter-Wallace*, 434 F.2d at 800. Only a brief evaluation of these characteristics is necessary to affirm the conclusion that the marks are dissimilar. Their appearance differs both in spelling and in the number of syllables. The marks do not sound the same: the "a" in "Match" is pronounced differently from the "a" in "Macho." The final vowel in "Macho" also distinguishes their sound.

Finally, the derivation and meaning of these words is entirely different. "Macho" is a word of Spanish derivation now in common use in the United States. It means strong, manly, virile. *The Random House College Dictionary*, 802 (1980). "Match" is a common English word of several meanings, each of them totally unrelated to "Macho." In addition, the term "Match" is related to Chesebrough's "Prince Matchabelli" product line, and is distinguishable from "Macho" on that basis.

We therefore agree that no genuine issue of fact exists as to the marks' dissimilarity. Dr. Einbond's conclusionary affidavit was insufficient to create a question of fact. The affidavit contained no facts other than the obvious sounds and spellings of the two words, about which there is no dispute. He did not mention their distinctly different meanings or origins. It was his opinion that the conclusion to be drawn from obvious facts varied from the conclusion reached by the court. The similarity or dissimilarity of these two words is a matter easily evaluated by laymen within the

realm of their common knowledge and experience. It is highly doubtful that expert testimony on the subject, of the type presented by the affidavit, would be of any real assistance to the trier of fact. Certainly it would be well within the discretion of the trial judge to exclude the expert opinion evidence under Fed.R.Evid. 702.[3]

Rule 56(e) of the Federal Rules of Civil Procedure states in part:

> Supporting and opposing affidavits shall be made on personal knowledge, shall set forth such facts as would be admissible in evidence, and shall show affirmatively that the affiant is competent to testify to the matters stated therein.

In this circumstance, when the issue of fact concerned matters of common knowledge and experience, and when it would have been clearly within the discretion of the trial court to exclude the expert opinion at trial under Fed.R.Evid. 702, it was not error to grant a summary judgment even

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[3]Fed.R.Evid. 702 states:

> If scientific, technical, or other specialized knowledge will assist the trier of fact to understand the evidence or to determine a fact in issue, a witness qualified as an expert by knowledge, skill, experience, training, or education, may testify thereto in the form of an opinion or otherwise.

The Notes of the Advisory Committee on the rules when proposed state in part:

> Whether the situation is a proper one for the use of expert testimony is to be determined on the basis of assisting the trier. "There is no more certain test for determining when experts may be used than the common sense inquiry whether the untrained layman would be qualified to determine intelligently and to the best possible degree the particular issue without enlightenment from those having a specialized understanding of the subject involved in the dispute." Ladd, *Expert Testimony*, 5 Vand.L.Rev. 414, 418 (1952). When opinions are excluded, it is because they are unhelpful and therefore superfluous and a waste of time. 7 Wigmore § 1918.

though the expert's conclusion differed from that of the court.[4]

B. *Remaining Factors Relevant to Confusion of Marks*

Faberge next argues that the district court erred in failing to consider expressly all factors relevant to the question of whether two marks are likely to be confused, as enumerated in *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d at 348-49. These factors include:

1. strength of the mark;
2. proximity of the goods;
3. similarity of the marks;
4. evidence of actual confusion;
5. marketing channels used;
6. type of goods and the degree of care likely to be exercised by the purchaser;
7. defendant's intent in selecting the mark; and
8. likelihood of expansion of the product lines.

The issue in this case is only whether there is a likelihood of confusion arising from similarity of two words, "Match" and "Macho". This action does not pertain to the likelihood of confusion arising from packaging or advertising. Factors 1 and 3, the strength of the mark and the similarity of the marks, have been addressed in the evaluation of the similarity of the names. With regard to factors 2, 5 and 6, there is no dispute. Chesebrough concedes that the product lines are identical and that the products move through the same marketing channels to the same outlets for purchase by the same class of customers. There is also agreement that the goods are relatively inexpensive and are thus chosen by

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[4]No affidavit was presented from a marketing expert with an opinion based upon facts such as market studies or observed public reaction to the product names. Such evidence could have raised a genuine issue of fact, whereas the affidavit presented did not.

casual purchasers who invest little or no time or care in their selection. There is no question of fact on these issues because there is no dispute; Faberge's contention is conceded. No issue can be raised concerning factor 7, Chesebrough's intent in selecting the mark, for at the time it began development and use of "Match", Faberge had not yet acquired "Macho." Factors 4 and 8, evidence of actual confusion and likelihood of expansion of product lines, are considerations that would have to await the manner in which Chesebrough products are eventually marketed and the use that is made of the trademark. Such questions are not ripe for disposition at this time.

Because there are no genuine issues of fact, the case is reduced to the legal issue of whether a likelihood of confusion exists from the use of the word "Match" as a trademark. *Alpha Industries, Inc. v. Alpha Steel Tube & Shapes, Inc.*, 616 F.2d 440, 443-44 (9th Cir. 1980). In view of the dissimilarity of the words, the lack of intent to infringe, and the total absence of evidence of actual or potential confusion of the undressed marks, the district court correctly concluded that no likelihood of confusion existed.

The remaining claims, which Faberge attempts to raise for the first time before this court, are without merit.

The judgment of the district court is AFFIRMED.

Order.

United States Court of Appeals for the Ninth Circuit.

Chesebrough-Pond's, Inc., a corporation, Plaintiff-Appellee, v. Faberge, Incorporated, a corporation, Defendant-Appellant. No. 80-5117. D.C. No. CV 78-3990-WPG.

Filed: March 18, 1982.

Appeal from the United States District Court for the Central District of California.

Before: HUG, FARRIS and BOOCHEVER, Circuit Judges.

The panel as constituted in the above case has voted to deny the petition for rehearing and to reject the suggestion for a rehearing en banc.

The full court has been advised of the en banc suggestion and no judge of the court has requested a vote on it. Fed. R. App. P. 35(b).

The petition for rehearing is denied and the suggestion for a rehearing en banc is rejected.

Memorandum to Counsel.

United States District Court, Central District of California.

Chesebrough-Pond's Inc., a corporation, Plaintiff, v. Faberge, Incorporated, a corporation, Defendant.

Faberge, Incorporated, a corporation, Counterclaimant, v. Chesebrough-Pond's Inc., a corporation, Counterdefendant. Civil Action No. 78-3990-WPG.

The court has modified slightly the Plaintiff's Second Proposed Findings of Fact and Conclusions of Law and has signed and filed such findings and a final judgment in the form submitted by the plaintiff. This was done after giving careful consideration to the initial objections by the defendant to the plaintiff's submission; the plaintiff's response thereto; and the defendant's objection to the second submission. In this memorandum, I set out a brief rationale of the basis for the action taken:

(a) For the most part, I agree with the plaintiff's responses to the defendant's criticisms and with the resulting changes reflected in the second set of findings.

(b) The only change that I made in the findings was to make clear that my conclusion that there was a justiciable controversy giving jurisdiction to this court is based entirely upon the letter of August 25, 1975. This is in fulfillment of the request made by the defendant.

I agree with the defendant that this court lacks jurisdiction over trademark registration and opposition proceedings. However, this court does have jurisdiction over matters pertaining to trademark infringement, including declaratory relief if there is a justiciable controversy. I think that such a controversy exists here.

The plaintiff can reasonably infer that if the defendant would seriously oppose registration of "Match" because

of the existence of the defendant's trademark "Macho," there exists a grave risk of an infringement action on the same basis after the opposition proceeding has concluded. But this would likely occur several years down the road. It seems to me that the plaintiff it entitled to have the issue of "likelihood of confusion" finally and promptly decided, instead of, on the one hand, having to wait years for successive decisions by the Patent Office and the courts, or, on the other hand, proceeding with expensive promotion of "Match" at its peril.

This Court has no desire to encroach in any manner upon the functions of the Patent Office in this matter. However, the fact that the Patent Office has deferred to this court's determination of the infringement issue reassures this court that the interests of justice warrant the action here taken.

(c) I am unable to agree with the defendant that there are issues of fact here that render summary judgment inappropriate. For the reasons set forth in paragraphs 6, 7, 8 and 9 of the findings, it simply is not reasonable to conclude that "Match" is confusingly similar to "Macho," whether in the context of the trademarks here concerned, or otherwise. I am convinced that no reasonable jury would find to the contrary, and if they were to do so I would feel obliged to set aside such a verdict. Under these circumstances, I cannot justify putting the parties to the burden of an expensive trial.

I believe that the basis for this court's decision now is clear to the parties.

DATED: January 30, 1980.

/s/ William P. Gray
WILLIAM P. GRAY
United States District Judge

Plaintiff's Second Proposed Findings of Fact and Conclusions of Law.

United States District Court, Central District of California.

Chesebrough-Pond's Inc., a corporation, Plaintiff, v. Faberge, Incorporated, Defendant.

Faberge, Incorporated, a corporation, Counterclaimant, v. Chesebrough-Pond's Inc., a corporation, Counterdefendant. Civil Action No. 78-3990 WPG.

Filed January 30, 1980.

FINDINGS OF FACT

1. Plaintiff and Counterdefendant Chesebrough-Pond's Inc. (hereinafter "Chesebrough"), is a New York corporation with its principal place of business in Connecticut.

2. Defendant and Counterclaimant Faberge, Incorporated (hereinafter "Faberge"), is a Minnesota corporation with its principal place of business in New York.

3. This is a civil action in which Chesebrough seeks a declaratory judgment* under Counts 3-5 of the Complaint that its use of the trademark MATCH for men's cosmetics and toiletries does not constitute infringement of the federally registered mark MACHO, unfair competition, or false designation of origin under 15 U.S.C. §§ 1114(1), 1125(a) and 1126, and that the use of the mark MATCH does not constitute common-law trademark infringement, unfair competition or dilution of the trademark MACHO. Faberge has asserted a counterclaim against Chesebrough alleging that Chesebrough's use of the trademark MATCH for men's cosmetics and toiletries constitutes an infringement of its

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*The court's conclusion of the presence of a justiciable controversy is based entirely upon the letter from Faberge to Chesebrough, dated August 25, 1975, asserting that "Match" was confusingly similar to "Macho" and expressing an intention to initiate opposition proceedings.

federally registered mark MACHO, as well as unfair competition.

4. Faberge is the owner of Registration No. 952,848, issued February 6, 1973, of the trademark MACHO for personal hygiene spray.

5. Chesebrough has used the trademark MATCH for men's toiletries and cosmetics, including all purpose lotion, dusting powder, hair spray and conditioner, deodorant, scented soap and toilet lotion. Chesebrough has pending application serial No. 43,374, filed February 4, 1975, for registration of the trademark MATCH for all purpose toiletry lotion, dusting powder, hair spray and conditioner, spray deodorant and scented soaps. This application was approved for registration by the Examiner in the United States Patent and Trakemark Office and published in the Official Gazette on August 5, 1975. An opposition to the registration was filed by Faberge and that proceeding, Opposition No. 57,551, is under suspension pending the outcome of this action.

6. The trademarks MATCH and MACHO differ significantly in sound and appearance.

7. The word "macho" is identified in Faberge's Registration No. 952,848 as a Spanish word meaning "virile" or "manly". The word "macho" is defined in Velasquez, *A New Pronouncing Dictionary of the Spanish and English Languages* as follows, page 419:

"Masculine, vigorous, robust, male."

8. The word "match" has multiple meanings in the English language including the following as set forth in *Webster's New Collegiate Dictionary* (1973):

"(1) A person or thing equal or similar to another; (2) a pair suitably associated; (3) a contest between two or more parties; (4) to encounter successfully as

an antagonist; and (5) to fit together or make suitable for fitting together."

9. The marks MATCH and MACHO are wholly dissimilar in connotation and the impact of the two marks on purchasers in the marketplace would be substantially diverse.

10. It is not contested for the purpose of this motion that Faberge's registration of the MACHO mark is valid and that Faberge's predecessor made use of the mark MACHO prior to Chesebrough's use of MATCH; nor is it contested that Chesebrough and Faberge have used their respective trademarks MATCH and MACHO on identical or closely related goods—namely, low-priced men's cosmetics and toiletries sold through the same channels of trade to the same class of buyers—namely, the general consuming public, who are essentially casual purchasers who devote the same amount of time to the purchase of cosmetics and toiletries as they do to the purchase of other relatively inexpensive products at drug stores, department stores and the like.

11. Chesebrough adopted the mark MATCH prior to Faberge's acquisition and use of MACHO. The only evidence of the extent of use or advertising of MACHO by Faberge's predecessor shows that its sales and approximate advertising expenditures were not substantial and such total sales did not exceed $80,000 over a five year period. The record does not show that Chesebrough sought to trade on any goodwill or reputation which may have been established for the MACHO mark.

12. As applied to closely related or identical goods, the trademark MATCH of Chesebrough is not confusingly similar to the federally registered trademark MACHO of Faberge.

13. No finding is made by the Court respecting the possibility of confusion arising in the event plaintiff should adopt a trade dress for its MATCH products similar to that of Faberge.

CONCLUSIONS OF LAW

1. This Court has jurisdiction of the subject matter of Chesebrough's Counts 3-5 and Faberge's first counterclaim, pursuant to 28 U.S.C. §§ 1338(a), 1338(b), 2201 and 2202 and 15 U.S.C. § 1121 and a substantial controversy between the parties exists as to these issues, stemming from the letter of August 25, 1970.

2. The basic test of trademark infringement, unfair competition and false designation of origin under the Lanham Act and under the common-law is "likelihood of confusion". Trademark dilution requires a showing of some degree of confusing similarity of the trademarks in question. See *Friend v. H. A. Friend & Co.*, 416 F.2d 526, 531, 163 USPQ 159, 162 (9th Cir. 1969) cert. den'd 397 U.S. 914, 25 L.Ed.2d 94, 90 S.Ct. 916, 164 USPQ 481 (1970) and *Fleischmann Distilling Corp. v. Maier Brewing Co.*, 314 F.2d 149, 136 USPQ 508 (9th Cir. 1963). McCarthy, *Trademarks and Unfair Competition*, Vol. 2, §§ 23.1 and 27.5(A).

3. Regardless of all other factors which bear on the question, it is clear from a simple comparison of the marks themselves as to sound, appearance and meaning that there is no likelihood of confusion among an appreciable number of reasonably prudent buyers in the simultaneous uses by the parties of the marks MATCH and MACHO. *Alladin Plastics, Inc. v. Jerrold Stephen Co.*, 362 F.2d 532, 150 USPQ 10 (9th Cir. 1966) and *B&L Sales Associates v. H. Daroff & Sons, Inc.*, 421 F.2d 352, 165 USPQ 353 (2nd Cir. 1970).

4. Accordingly, there is no genuine issue of fact precluding summary judgment or Chesebrough in this case.

5. Chesebrough's use of the trademark MATCH for men's cosmetics, toiletries and related products does not constitute trademark infringement, unfair competition or false designation of origin under 15 U.S.C. §§ 1114(1), 1125(a) and 1126.

6. Chesebrough's use of the trademark MATCH for men's cosmetics, toiletries and related products does not constitute common-law trademark infringement of the MACHO mark or unfair competition with Faberge.

7. Chesebrough's use of the MATCH trademark for men's cosmetics, toiletries and related products does not constitute a dilution of Faberge's trademark MACHO.

APPROVED AND SO ORDERED
THIS 30 DAY OF JANUARY, 1980.

/s/ William P. Gray
United States District Judge

Submitted by:

HARRIS, KERN, WALLEN & TINSLEY
Attorneys for Plaintiff
and Counterdefendant
Chesebrough-Pond's Inc.
By /s/ Richard A. Wallen
Richard A. Wallen
Dated: January 7, 1980

Final Judgment.

United States District Court, Central District of California.

Chesebrough-Pond's Inc., a corporation, Plaintiff, v. Faberge, Incorporated, a corporation, Defendant.

Faberge, Incorporated, a corporation, Counterclaimant, v. Chesebrough-Pond's Inc., a corporation, Counterdefendant. Civil Action No. 78-3990 WPG.

Filed: January 30, 1980.

The Motion for Partial Summary Judgment of Plaintiff and Counterdefendant Chesebrough-Pond's Inc. under Rule 56 of the Federal Rules of Civil Procedure and the Motion of Defendant and Counterclaimant Faberge, Incorporated for Transfer under 28 U.S.C. § 1404 having come on for hearing on October 29, 1979, and the Court having considered the memoranda of points and authorities filed by the parties on said motions, the affidavits of Messrs. Horowitz, Murray, Sanford and Scagnelli previously filed in this action, the affidavits of Professor Einbond and Mr. Frederick in opposition to the motion for summary judgment, the affidavits of Messrs. Scagnelli, Stein, Neagley, Lacher and Frederick on the motion to transfer, the defendant-counterclaimant's offer to dismiss the counterclaim for malicious prosecution and all other pleadings and papers filed herein; the Court having previously concluded, in its Order dated April 24, 1979, denying defendant's motion to dismiss that it has jurisdiction of the subject matter herein; and the Court having heard and considered the arguments of counsel on said motions on October 29, 1979 and counsel for plaintiff-counterdefendant having agreed at said hearing to dismiss Counts 1, 2, 6 and 7 of the Complaint without prejudice and counsel for defendant-counterclaimant having reiterated his agreement to dismiss without prejudice the counterclaim

for malicious prosecution; and in accordance with the Court's Findings of Fact and Conclusions of Law on the motion for summary judgment;

IT IS HEREBY ORDERED AND ADJUDGED THAT:

1. Plaintiff's Motion for Partial Summary Judgment on Counts 3, 4 and 5 of the Complaint and on the first Counterclaim of defendant-counterclaimant Faberge, Incorporated is hereby granted in its entirety.

2. Defendant's motion to transfer under 28 U.S.C. § 1404 is hereby denied.

3. The remaining counts of the Complaint—namely, Counts 1, 2, 6 and 7, are dismissed without prejudice on motion of the plaintiff.

4. The second counterclaim for malicious prosecution is dismissed without prejudice on motion of the defendant.

ACCORDINGLY, IT IS FURTHER ORDERED AND ADJUDGED THAT:

5. Chesebrough has the right to use, in connection with cosmetics, toiletries, and related products, the trademark MATCH, insofar as the word itself is concerned, free from interference from Faberge, its officers, its agents, servants, employees, attorneys, privies, representatives, successors, and assigns, and any and all persons acting in concert or in participation with them, whether separately or jointly, in and throughout the United States its territories and possessions or in any foreign country where the activities of Faberge or Chesebrough have a substantial effect on interstate commerce or any commerce which Congress may lawfully regulate.

6. Faberge, its officers, agents, servants, attorneys, privies, representatives, successors, and assigns, and any and all other persons acting in concert or participation with

them, either separately or jointly, are hereby permanently enjoined from:

a. interfering with, or threaenting to interfere with the use of the trademark MATCH by Chesebrough, its related companies, successors, or assigns, in connection with its or their business in and throughout the United States its territories and possessions or in any foreign country where the activities of Faberge or Chesebrough have a substantial effect on interstate commerce or any commerce which Congress may lawfully regulate;

b. instituting or prosecuting any suit or other proceeding, placing in issue the right of Chesebrough or said related companies, successors, or assigns, to register or use the mark MATCH in connection with cosmetics, toiletries, and related products in and throughout the United States its territories and possessions or in any foreign country where the activities of Faberge or Chesebrough have a substantial effect on interstate commerce or any commerce which Congress may lawfully regulate.

7. Faberge shall pay the cost and disbursements of Chesebrough in connection with Counts 3-5 and Faberge's first Counterclaim in the sum of $_____ .

APPROVED AND SO ORDERED
THIS 30th DAY OF JANUARY, 1980

/s/ William P. Gray
United States District Judge

Submitted by:

HARRIS, KERN, WALLEN & TINSLEY

Attorneys for Plaintiff
and Counterdefendant
Chesebrough-Pond's Inc.

By /s/ Richard A. Wallen
Richard A. Wallen

Dated: January 7, 1980

Decision.

Chesebrough-Pond's Inc., Appellant, v. Faberge, Incorporated, Appellee. Appeal No. 79-558.

United States Court of Customs and Patent Appeals.

April 17, 1980.

Appeal was taken from a decision of the Trademark Trial and Appeal Board which granted plaintiff's motion for summary judgment dismissing defendant's counterclaim for cancellation of plaintiff's registration of a trademark. The Court of Customs and Patent Appeals, Rich, J., held that: (1) the Court had jurisdiction over the appeal, and (2) the dismissal of a counterclaim for the defendant's failure to timely file an opposition to the plaintiff's motion for summary judgment was not an abuse of discretion.

Affirmed.

Marie V. Driscoll, New York City, attorney of record, for appellant.

Richard Whiting, New York City, attorney of record for appellee, David M. McConoughey, New York City, of counsel.

Before MARKEY, Chief Judge, RICH, BALDWIN, and MILLER, Associate Judges, and FORD,* Judge.

RICH, Judge.

This appeal is from the decision of the Patent and Trademark Office (PTO) Trademark Trial and Appeal Board (TTAB) which granted appellee Faberge's motion for summary judgment dismissing Chesebrough-Pond's (hereinafter "Chesebrough") counterclaim for cancellation of Faberge's registration of the mark MACHO in opposition No. 57,551. We affirm.

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*The Honorable Morgan Ford, Judge, United States Customs Court, sitting by designation.

Background

Faberge opposed registration by Chesebrough of the mark MATCH for use on men's toiletries, based on its use and registration of the mark MACHO for the same goods. Chesebrough counterclaimed for cancellation of Faberge's registration, asserting several grounds for invalidity of the registration, the details of which are not relevant here.

After some discovery, Faberge moved for summary judgment dismissing the counterclaim on the basis that the allegations therein were groundless. Affidavits and exhibits were filed in support of the motion, in refutation of the contentions in the counterclaim, in an effort to establish absence of disputed material facts.

Chesebrough did not wish the motion to be decided without the benefit of additional discovery on the issues raised in its counterclaim. On November 1, 1977, the TTAB set a date for a pre-trial conference and requested the parties to file statements concerning the status of the discovery process. At the conference, future discovery arrangements were detailed, including deposition taking and document inspection. Chesebrough's time to respond to the motion for summary judgment was extended until February 28, 1978.[1]

On February 27, 1978, Chesebrough again moved for an extension of time in which to respond to the motion, asking

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[1]On November 9, 1977, Faberge advised the TTAB that Chesebrough was technically in default concerning the motion for summary judgment, since it had not filed a brief in opposition. The TTAB had reminded Chesebrough of the need to respond by October 28, 1977, stating that additional time in which to respond would be granted if requested. Chesebrough filed such a request on October 27, 1977, for the purpose, inter alia, of obtaining further discovery concerning the counterclaim isses, in a paper entitled RESPONSE TO MOTION FOR SUMMARY JUDGMENT.

the TTAB to set some date in the future. Faberge consented to the request, and it was granted by the TTAB.

On April 13, 1978, Chesebrough again renewed its motion for an extension of time. The parties stipulated that the time should be extended to June 20, 1978, and the TTAB granted the motion on April 27, 1978.

On June 22, 1978, Chesebrough moved to amend its counterclaim by removing certain allegations and inserting other allegations. Simultaneously it also filed a MEMORANDUM IN OPPOSITION TO MOTION FOR SUMMARY JUDGMENT.

On August 7, 1978, the TTAB granted the motion to amend the counterclaim, and set August 28, 1978, as the date for renewal of Faberge's motion for summary judgment on the amended counterlaim. October 2, 1978, was set as the date for Chesebrough's response to the renewed summary judgment motion.

Faberge filed its renewed motion on August 21, 1978. On September 27, 1978, the TTAB agreed to yet another request by Chesebrough for an extension of time, *setting October 30, 1978, as the due date*. The parties were directed to file a stipulated record for purposes of the motion for summary judgment. Faberge was to compile and deliver the record to Chesebrough by October 2, 1978. The record was mailed to Chesebrough on September 29, 1978.

On October 20, 1978, Chesebrough again moved for an extension of time in which to file its brief, stating the circumstance that it had just brought suit against Faberge in the Central District of California on issues said to be dispositive of the opposition. Filed concurrently was a motion to suspend the TTAB proceedings pending the outcome of the civil action.

Faberge wrote to the TTAB on October 26, 1978, submitting the record which it had prepared in accordance with the TTAB request, and attached copies of its unanswered communications sent to Chesebrough seeking compliance with the stipulation request.

The Decision Below

October 30, 1978, passed without the submission of Chesebrough's brief in opposition to Faberge's motion for summary judgment on the counterclaim. It does not appear from the record that Chesebrough ever contacted the TTAB to inquire of the status of its latest request for an extension of time.

One month later, on November 30, 1978, the TTAB issued its decision denying the last request for an extension of time. The TTAB also granted Faberge's motion for summary judgment as conceded under the provisions of 37 CFR 2.127(a), which reads in pertinent part:

> Briefs in opposition to a motion shall be filed within 15 days from the date of service of the motion unless another time is specified by the Trademark Trial and Appeal Board or the time is extended on request. *Where a party fails to file a brief in opposition to a motion, the Trademark Trial and Appeal Board may treat the motion as conceded.* [Emphasis ours.]

The TTAB opinion first detailed the chronology of events which we have set out above, acknowledging the numerous instances in which requests for extensions of time had been granted to Chesebrough. Then, with respect to the application of 37 CFR 2.127(a), the TTAB stated:

> In view of the repeated extensions granted applicant for responding to the motion, we believe that this is a proper case to invoke the provisions of that rule.

Accordingly, we are constrained to proceed on opposer's motion by way of default.

Positions of the Parties

Faberge argues that this court does not have jurisdiction to hear this appeal. Its position is that the denial by the TTAB of a request for an extension of time in which to file a brief, as well as the granting of a motion under the provisions of 37 CFR 2.127(a), is not a "decision" of the TTAB within the meaning of § 21 of the Lanham Act (15 U.S.C. § 1071), the statutory grant of jurisdiction to this court to entertain appeals from the TTAB. Section 21(a)(1) provides, in pertinent part:

> * * * [a] party to an opposition proceeding * * * [or a] party to a cancellation proceeding, * * * who is dissatisfied with the decision of the [TTAB], may appeal to the United States Court of Customs and Patent Appeals * * *.

Faberge contends that the proper avenue of relief for Chesebrough from the action of the TTAB is by petition to the Commissioner under 37 CFR 2.146 if a request to the TTAB for reconsideration of its decision under 37 CFR 2.127(b) is denied.

For this proposition, Faberge relies on decisions of this court in both patent and trademark cases which set forth the "appealable versus petitionable dichotomy." In these cases, this court has drawn a general distinction between substantive and procedural determinations.[2] Chesebrough notes that

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[2]These cases include *In re Searles*, 57 CCPA 912, 422 F.2d 431, 164 USPQ 623 (1970); *In re James*, 57 CCPA 1371, 432 F.2d 473, 167 USPQ 403 (1970), both of which were ex parte patent appeals, and *Dan Robbins & Associates v. Questor Corp.*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979); *Hercules, Inc. v. National Patent Development Corp.*, 524 F.2d 1227, 187 USPQ 668 (CCPA 1975); *Palisades Pageants v. Miss America Pageants*, 58 CCPA 1225, 442 F.2d 1385, 169 USPQ 790, *cert. denied* 404 U.S. 938, 92 S.Ct. 269, 30 L.Ed.2d 251 (1971); *Martin v. Crown Zellerbach Corp.*, 57 CCPA 968, 422 F.2d 918, 165 USPQ 171, *cert. denied*, 400 U.S. 911, 91 S.Ct. 140, 27 L.Ed.2d 151 (1970); *United States Treasury v. Synthetic Plastics Co.*,

the TTAB considered the motion for summary judgment to be dispositive of the case, since it addressed the issue prior to granting the motion to suspend the proceedings. This is relied upon as conclusive on the issue of appealability and hence jurisdiction. Any dispositive ruling is urged as appealable under § 21 of the Lanham Act.

Chesebrough attempts to distinguish the decisions of this court relied upon by Faberge. It is urged that the ex parte patent appeals are totally nonpertinent and the trademark cases are dismissed by Chesebrough as involving facts not analogous to the instant situation.

Chesebrough relies on this court's decision in *Knickerbocker Toy Co. v. Faultless Starch Co.*, 467 F.2d 501, 175 USPQ 417 (CCPA 1972), where we gave "practical construction" to the final judgment rule, considering the interests in both the administration of justice and the separability of the issue decided from those left undecided. We are urged to hear the appeal now in the interest of judicial economy.

Chesebrough asks that we reverse the decision of the TTAB because it amounts to an abuse of discretion. It notes that summary judgment is not favored, and, likewise, that default judgments are not favored. It states that the request for an extension of time was made, in the last instance, for an overwhelmingly convincing reason—that a civil action potentially dispositive of the issues had been brought, and a motion was pending to suspend the proceedings.

OPINION

Jurisdiction

In considering the question of this court's jurisdiction over this appeal, two distinct issues arise: the significance of the interlocutory nature of the appeal, and the significance of the fact that the decision below was based upon appli-

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52 CCPA 967, 341 F.2d 157, 144 USPQ 429 (1965); *In re Maloy*, 51 CCPA 1081, 328 F.2d 933, 140 USPQ 599 (1964); all of which were trademark appeals.

cation of TTAB procedural rules rather than on the merits of the counterclaim. We shall deal with these issues in order.

This court reviews only final decisions of the TTAB. *Aerco International, Inc. v. Vapor Corp.*, 608 F.2d 518, 203 USPQ 882 (CCPA 1979). Certain interlocutory appeals are sufficiently final for the purpose of immediate review; if the appealed issue is sufficiently separate and distinct from the issues remaining unadjudicated, and the goal of judicial economy would be served by prompt resolution of the dispute, this court has allowed the appeal of interlocutory orders. *Toro Co. v. Hardigg Industries, Inc.*, 549 F.2d 785, 193 USPQ 149 (CCPA 1977); *see also Stabilisierungsfonds Fur Wein v. Zimmermann-Graeff KG*, 198 USPQ 154 (CCPA 1978) (issue discussed, appeal dismissed for lack of jurisdiction). Another factor which we have considered is whether the decision appealed from has finally disposed of a right asserted by one of the parties and foreclosed its further consideration. *R. G. Barry Corp. v. Mushroom Makers, Inc.*, 609 F.2d 1002, 1005, 204 USPQ 195, 198 (CCPA 1979).

We take jurisdiction in this case. The decision appealed from satisfies the above tests. The grant of summary judgment has finally decided Chesebrough's right to assert its counterclaim, thus precluding further consideration of that issue. The issues involved in the instant counterclaim are separate and distinct from the issues remaining in the opposition. This is unlike the situation in *R. G. Barry Corp., supra*, where the TTAB *denied* a motion for summary judgment, thus leaving the possibility that the TTAB could decide in favor of the movant on the ultimate issues and render any appeal on that issue moot.

We find the second reason offered by Faberge in opposing jurisdiction in this case to be without merit. While it is true that the decision below resulted from application of TTAB

rules, its effect is nonetheless substantive since it finally decides Chesebrough's right to assert its counterclaim. We are mindful of the fact that the dividing line between petitionable and appealable matters can be and often is drawn between procedural and substantive decisions.[3] To do so in this situation would, however, exalt form over substance. Even though the TTAB decision was based on a procedural rule, it finally disposed of an asserted right.

Proper Exercise of Discretion

The issue to be resolved in this appeal is a simple one. Can the TTAB, under the circumstances of this case, apply its rule to the effect that an unopposed motion may be treated as conceded? We hold it can.

Litigation is run by rules designed to assure orderly conduct of the proceedings. One of those rules is the timely submission of briefs *unless an extension of time has been granted*. An attorney has no right to assume that extensions of time will always be granted automatically, which, it appears, is what the attorney for Chesebrough assumed here.[4]

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[3]We do not intend our decision here to effect the established rule that errors of a procedural nature occurring in the TTAB or the other PTO tribunals are normally redressed by way of petition to the Commissioner. The exception which we carve out here is narrow and is dictated only by the substantial substantive effect of the TTAB's action. This is one of the rare circumstances in which a procedural ruling by the TTAB is virtually indistinguishable from a decision on the merits in that it finally disposes of the counterclaim.

We caution that our holding that we have jurisdiction to review this essentially procedural decision of the TTAB is based soley on the circumstance that the decision resulted in a grant of summary judgment dismissing the counterclaim in its entirety. We will not normally entertain appeals questioning the propriety of other procedural rulings by PTO tribunals.

[4]Present counsel for appellant was not involved in the proceedings below.

We see no good reason why the brief was not submitted on time. The record is devoid of any excuse by way of extenuating circumstances proffered by counsel for Chesebrough; there appear to be none. The argument that the TTAB knew of Chesebrough's "vigorous" opposition to the motion for summary judgment is irrelevant. It can always be said that one party to an adversary proceeding vigorously opposes the position of the other.

Given the repeated delays and extensions granted to Chesebrough in this case and its accommodation by the TTAB until the last extension was refused, we think the TTAB had little choice but to do what it did; it must be allowed the mechanism which is available by rule in order to enforce the orderly conduct of its proceedings. We do not find the slightest hint of an abuse of discretion in its decision. Regarding Chesebrough's complaint that a month elapsed between the due date of the brief and the TTAB decision, we remind Chesebrough that the burden is on it, not on the TTAB, to assure that it files its papers on time.

The decision of the TTAB is *affirmed*.

AFFIRMED.

Complaint for Damages for Fraudulent Registration of a Trademark, Cancellation of Trademark Registration, and for Declaratory Judgment Re Trademark Infringement, Unfair Competition and Dilution.

United States District Court, Central District of California.

Chesebrough-Pond's Inc., a corporation, Plaintiff v. Faberge, Incorporated, a corporation, Defendant. Civil Action No. 78 3990 WPG.

Filed: October 18, 1978.

FIRST COUNT

1. Plaintiff, Chesebrough-Pond's Inc. (hereinafter "Chesebrough"), is a New York corporation with its principal place of business in Connecticut.

2. Defendant, Faberge, Incorporated (hereinafter "Faberge") is a Minnesota corporation with its principal place of business in New York.

3. Venue is proper within this Judicial District under 28 U.S.C. §§ 1391(b) and (c) as Faberge is qualified to do business and is doing business within this state and this Judicial District.

4. This action for damages for fraudulent registration of a trademark, cancellation of trademark registration, and for declaratory judgment re trademark infringement, unfair competition and dilution arises under the Trademark Act of 1946 (15 U.S.C. §§ 1051-1127), California Civil Code § 3369 and California Business and Professions Code § 14330. The Court has jurisdiction pursuant to 15 U.S.C. §§ 1119, 1120 and 1121, and 28 U.S.C. §§ 1338(a), 1338(b), 2201 and 2202.

5. Chesebrough is in the business of manufacturing, marketing and selling a variety of cosmetic and toiletry products throughout the United States.

6. Faberge is in the business of manufacturing, marketing, and selling a variety of cosmetic and toiletry products throughout the United States.

7. On October 12, 1971, Faberge's predecessor, Ralph Lacher, d/b/a/ Jordan K. Rand Limited filed with the United States Patent and Trademark Office ("Trademark Office") an application to register the word "Macho" as a trademark for personal hygiene spray. The application claimed November, 1970 as the date of first use of "Macho" on personal hygiene spray.

8. The Trademark Office assigned Serial No. 404,812 to the "Macho" application and examined it for compliance with the Federal Trademark Act statutory requirements for registration (15 U.S.C. §§ 1051-1127). Based upon the representations and claims set forth in the application, the Trademark Office caused the "Macho" application to be published in the November 21, 1972 issue of the Official Gazette of the Trademark Office pursuant to 15 U.S.C. § 1062(a). The "Macho" application subsequently was issued as United States Trademark Registration No. 952,848 on February 6, 1973.

9. The November, 1970 claim of first use of "Macho" on personal hygiene spray contained in the "Macho" application which matured to United States Trademark Registration No. 952,848 was false. The first use of "Macho" on such product occurred at a later time.

10. Chesebrough is informed and believes that the November, 1970 claim of first use of "Macho" on personal hygiene spray contained in the "Macho" application which matured to United States Trademark Registration No.

952,848 was made by Ralph Lacher, d/b/a/ Jordan K. Rand Limited with full knowledge of such falsity.

11. Chesebrough is informed and believes that the claim of ownership of "Macho" in Faberge's predecessor, Ralph Lacher, d/b/a Jordan K. Rand Limited contained in the "Macho" application which matured to United States Trademark Registration No. 952,848 was false. Faberge's predecessor, Ralph Lacher, d/b/a Jordan K. Rand Limited did not own the rights to "Macho".

12. Chesebrough is informed and believes that the claim of ownership of "Macho" in Faberge's predecessor, Ralph Lacher, d/b/a Jordan K. Rand Limited contained in the "Macho" application which matured to United States Trademark Registration No. 952,848 was made by Ralph Lacher, d/b/a Jordan K. Rand Limited with full knowledge of such falsity.

13. On or about June 3, 1975, Faberge's predecessor, Ralph Lacher, d/b/a Jordan K. Rand Limited assigned its entire right, title, and interest in and to the word "Macho" and United States Trademark Registration No. 952,848 to Faberge.

14. On February 4, 1975, Chesebrough filed with the Trademark Office an application to register the mark "Match" as a trademark for all purposes toiletry lotion, dusting powder, hair spray and conditioner, spray deodorant, and scent soaps. The Trademark Office assigned the "Match" application Serial No. 43,374 and caused it to be published in the August 5, 1975 issue of the Official Gazette of the Trademark Office pursuant to 15 U.S.C. § 1062(a).

15. On or about October 6, 1975, Faberge filed a notice of opposition in the Trademark Office pursuant to 15 U.S.C. § 1063 opposing registration of the "Match" mark to Chesebrough for all purpose toiletry lotion, dusting powder,

hair spray and conditioner, spray deodorant, and scent soaps. The filing of the notice of opposition initiated a proceeding between the parties before the Trademark Trial and Appeal Board of the Trademark Office ("the proceeding").

16. Faberge alleged ownership of United States Trademark Registration No. 952,848 for "Macho" in its notice of opposition initiating the proceeding.

17. In its notice of opposition, and throughout the course of the proceeding, Faberge has repeated, ratified, and confirmed the following claims contained in the "Macho" application which matured to United States Trademark Registration No. 952,848.

A. That "Macho" was first used on personal hygiene spray in November, 1970.

B. That Faberge's predecessor, Ralph Lacher, d/b/a Jordan K. Rand Limited owned the rights to "Macho".

18. Chesebrough is informed and believes that the November, 1970 claim of first use of "Macho" on personal hygiene spray contained in the "Macho" application which matured to United States Trademark Registration No. 952,848 was false and was repeated, ratified, and confirmed by Faberge with full knowledge of such falsity.

19. Chesebrough is informed and believes that the claim of ownership of "Macho" in Faberge's predecessor, Ralph Lacher, d/b/a Jordan K. Rand Limited contained in the "Macho" application which matured to United States Trademark Registration No. 952,848 was false and was repeated, ratified, and confirmed by Faberge with full knowledge of such falsity.

20. Even before institution of the opposition proceedings, Faberge has stated in writing its position that the

Chesebrough mark "Match" violates its registered trademark rights to the word "Macho". This position was set forth in a certified letter addressed to the President of Chesebrough.

21. In the Trademark Office proceeding subsequent instituted by Faberge, Faberge pursued and amplified its assertion that the Chesebrough "Match" mark violates its trademark rights to the word "Macho". In its notice of opposition initiating the proceeding, Faberge alleged that the Chesebrough "Match" mark so resembled the word "Macho" as to be likely to cause "confusion, mistake, and deception" when applied to the products set forth in the Chesebrough "Match" trademark application.

22. Chesebrough is actively preparing to proceed with full scale commercial sale of cosmetic and toiletry products under the "Match" mark. The Faberge assertion that the Chesebrough "Match" mark violates Faberge trademark rights in the falsely or fraudulently registered mark "Macho" places Chesebrough under the apprehension that Faberge will file a trademark and unfair competition suit to enjoin Chesebrough from using the "Match" mark for cosmetic and toiletry products. Chesebrough is further apprehensive that Faberge will file such suit immediately after "Match" cosmetic and toiletry products reach the market in quantity, causing irreparable injury to Chesebrough.

23. The attempts to enforce such registration and the proceeding brought by Faberge as aforesaid was initiated for the purpose, and with the intent of harassing Chesebrough and forestalling the full scale commercial sale of cosmetic and toiletry products under its "Match" mark.

24. By reason of the foregoing, Faberge's actions have damaged and will continue to damage and irreparably injure Chesebrough.

SECOND COUNT

25. This count seeks cancellation of United States Trademark Registration No. 952,848 for fraudulent registration pursuant to 15 U.S.C. § 1064(c).

26. Plaintiff repeats and realleges Paragraphs 1 through 24 hereof as though fully set forth herein.

THIRD COUNT

27. This count seeks a declaratory judgment of the absence of federal trademark infringement and unfair competition pursuant to 28 U.S.C. §§ 2201 and 2202.

28. Plaintiff repeats and realleges Paragraphs 1 through 26 hereof as though fully set forth herein.

29. Plaintiff repeats and realleges Paragraphs 1 through 26 hereof as though fully set forth herein.

30. Chesebrough and Faberge are presently and have for many years been direct competitors with respect to many of the cosmetic and toiletry products manufactured, marketed and sold by each company.

31. Faberge has stated in writing its position that the Chesebrough mark "Match" violates its trademark rights to the word "Macho". This position was set forth in a certified letter addressed to the President of Chesebrough.

32. Faberge pursued and amplified in the Trademark Office proceeding its assertion that the Chesebrough "Match" mark violates its trademark rights to the word "Macho". In its notice of opposition initiating the proceeding, Faberge alleged that the Chesebrough "Match" mark so resembled the word "Macho" as to be likely to cause "confusion, mistake, and deception" when applied to the products set forth in the Chesebrough "Match" trademark application.

33. Chesebrough is actively preparing to proceed with full scale commercial sale of cosmetic and toiletry products

under the "Match" mark. The Faberge assertion that the Chesebrough "Match" mark violates Faberge trademark rights in the word "Macho" places Chesebrough under the apprehension that Faberge will file a trademark and unfair competition suit to enjoin Chesebrough from using the "Match" mark for cosmetic and toiletry products. Chesebrough is further apprehensive that Faberge will file such suit immediately after "Match" cosmetic and toiletry products reach the market in quantity, causing irreparable injury to Chesebrough.

34. Faberge has not retracted its charge that Chesebrough has violated its rights in the trademark "Macho", and therefore, an actual controversy currently exists between Faberge and Chesebrough with respect to Chesebrough's past use of the "Match" trademark and with respect to its continued use of its trademark.

35. To resolve the legal and factual questions raised by Faberge and to afford Chesebrough relief from the uncertainty and controversy which Faberge's assertion has caused, Chesebrough is entitled to a declaratory judgment of its rights pursuant to 28 U.S.C. §§ 2201-2202.

36. The use by Chesebrough of its mark "Match" is not in violation of any rights Faberge might have pursuant to 15 U.S.C. § 1114(1).

FOURTH COUNT

37. Plaintiff repeats and realleges Paragraphs 1 through 36 hereof as though fully set forth herein.

38. The use by Chesebrough of its mark "Match" is not in violation of any rights Faberge might have under the federal law of unfair competition as set forth in 15 U.S.C. §§ 1125(a) and 1126.

FIFTH COUNT

39. This count seeks a declaratory judgment of the absence of common law trademark infringement, dilution, and unfair competition pursuant to 28 U.S.C. §§ 2201 and 2202. Further subject matter jurisdiction arises in connection with this count as a substantial and related claim pursuant to 28 U.S.C. § 1338(b).

40. Plaintiff repeats and realleges Paragraphs 1 through 38 hereof as though fully set forth herein.

41. The use by Chesebrough of its mark "Match" is not in violation of any rights Faberge might have pursuant to principles of common law trademark infringement, dilution, and unfair competition.

SIXTH COUNT

42. This count seeks a declaratory judgment of trademark invalidity pursuant to 28 U.S.C. §§ 2201 and 2202. Further subject matter jurisdiction arises in connection with this count as a substantial and related claim pursuant to 28 U.S.C. § 1338(b).

43. Plaintiff repeats and realleges Paragraphs 1 through 41 as though fully set forth herein.

44. The word "Macho" has been abandoned and Registration No. 952,848 is correspondingly invalid and void on the following grounds:

A. That the assignment, on or about June 3, 1975, of the entire right, title, and interest in and to the word "Macho" and United States Trademark Registration No. 952,848 from Faberge's predecessor, Ralph Lacher, d/b/a Jordan K. Rand Limited to Faberge was an "assignment in gross" resulting in abandonment of the word "Macho" and invalidation of Registration No. 952,848.

B. That Faberge used the word "Macho" on goods substantially different from those on which it was used by Faberge's predecessor, Ralph Lacher, d/b/a Jordan K. Rand Limited resulting in abandonment of the word "Macho" and invalidation of Registration No. 952,848.

SEVENTH COUNT

45. This court seeks cancellation of United States Trademark Registration No. 952,848 pursuant to 15 U.S.C. § 1064(c) on the basis that the word "Macho" has been abandoned.

46. Plaintiff repeats and realleges Paragraphs 1 through 44 hereof as though fully set forth herein.

47. The word "Macho" has been abandoned on the grounds set forth in Paragraph 44 of Count Six and Registration No. 952,848 should be cancelled.

WHEREFORE, plaintiff demands Judgment:

1. That Chesebrough receive as damages for the false or fraudulent registration of "Macho" (a) its costs, attorneys' fees, and disbursements (i) for defending the Trademark Office proceeding, and (ii) for prosecuting the present action, and (b) the damages sustained in its business resulting from the Faberge employment of "Macho" Registration No. 952,848 as a basis for objection to Chesebrough's use and registration of the "Match" mark.

2. That the Commissioner of Patents and Trademarks be ordered to cancel Registration No. 952,848.

3. Declaring the use by Chesebrough of its mark "Match" not to be in violation of any rights Faberge might have pursuant to 15 U.S.C. § 1114(1).

4. Declaring the use by Chesebrough of its mark "Match" not to be in violation of any rights Faberge might

have pursuant to the federal law of unfair competition as set forth in 15 U.S.C. §§ 1125(a) and 1126.

5. Declaring the use by Chesebrough of its mark "Match" not to be in violation of any rights Faberge might have pursuant to principles of common law trademark infringement, dilution, and unfair competition.

6. Declaring the word "Macho" to be abandoned.

7. Declaring Registration No. 952,848 to be invalid and void.

8. Declaring that Chesebrough has the right to use, in connection with cosmetics, toiletries, and related products, the trademark "Match" free from interference by Faberge, its officers, agents, servants, employees, attorneys, privies, representatives, successors, and assigns, and any and all persons acting in concert or in participation with them, either separately or jointly, in the United States or in any foreign country where the activities of Faberge or Chesebrough have a substantial effect on interstate or foreign commerce.

9. That Faberge, its officers, agents, servants, attorneys, privies, representatives, successors, and assigns, and any and all persons acting in concert or in participation with them, either separately or jointly, be permanently enjoined from:

A. Interfering with, or threatening to interfere with, the use of the trademark "Match" by Chesebrough, its related companies, successors, or assigns, in connection with its or their business.

B. Instituting or prosecuting any suit or other proceeding placing in issue the right of Chesebrough or said related companies, successors, or assigns, to register or use the mark "Match" in connection with cosmetics, toiletries, and related products.

10. That Faberge pay the costs, attorneys' fees, and disbursements of Chesebrough in this action.

11. That Chesebrough have such other and further relief as the Court may deem just, proper, and equitable.

Dated: October 18, 1978

HARRIS, KERN, WALLEN & TINSLEY

By /s/ Richard A. Wallen

Richard A. Wallen

Attorneys for Plaintiff

Answer.

United States District Court, Central District of California.

Chesebrough-Pond's Inc., a corporation, Plaintiff, v. Faberge, Incorporated, a corporation, Defendant. Civil No. CV 78-3990 WPG.

Filed: May 21, 1979.

Defendant, Faberge, Incorporated, without waiving its right of review of the denial of its motion to dismiss and reserving its right to seek transfer of this action to the United States District Court for the Southern District of New York, hereby answers the correspondingly numbered paragraphs of the Complaint herein as follows:

1. Admitted.

2. Admitted.

3. Admitted.

4. Denied.

5. Admitted.

6. Admitted.

7. Admitted.

8. Admitted, except that defendant is without knowledge or information sufficient to form a belief as to the truth of the allegation that the representations and claims set forth in the application caused the Trademark Office to act as alleged and leaves plaintiff to such proof thereof as it may be advised. Defendant avers that the application was in all respects properly examined and published and Registration No. 952,848 was in all respects properly issued by the Trademark Office.

9. Denied.

10. Construing this paragraph as a statement of allegations made upon information and belief, the allegations are denied.

11. Construing this paragraph as a statement of allegations made upon information and belief, the allegations are denied.

12. Construing this paragraph as a statement of allegations made upon information and belief, the allegations are denied.

13. The allegations of this paragraph are denied as stated. Defendant avers that on or about June 3, 1975, Faberge's predecessor, Ralph Lacher, formerly doing business as Jordan K. Rand Limited, a sole proprietorship, which proprietorship was on or about October 21, 1971, incorporated, assigned the entire right, title and interest in and to the word "Macho" and United States Trademark Registration No. 952,848 to Faberge.

14. Defendant is without knowledge or information sufficient to form a belief as to the truth of the allegations of this paragraph as stated, and leaves plaintiff to such proof thereof as it may be advised, except that defendant avers that in the August 5, 1975, issue of the *Official Gazette* of the Trademark Office, notice was published of Chesebrough's application Serial No. 43,374 to register the word "Macho" as a trademark for "all purpose toiletry lotion, dusting powder, hair spray and conditioner and scented soaps" in Class 3 and "personal deodorant" in Class 5.

15. Admitted, except that the goods for which Faberge filed the Notice of Opposition were all purpose toiletry lotion, dusting powder, hair spray and conditioner and scented soaps in Class 3 and personal deodorant in Class 5.

16. Admitted.

17. The allegations of this paragraph are denied as stated. Defendant admits that it asserted in its notice of opposition with reference to the mark of the application which matured to United States Trademark Registration No. 952,848 that "Macho" was first used on personal hygiene spray in November 1970, and that Faberge's predecessor, Ralph Lacher, dba Jordan K. Rand Limited had owned the rights to "Macho". Defendant further admits that defendant's position in this regard has not changed throughout the course of the opposition proceeding.

18. Construing this paragraph as a statement of allegations made upon information and belief, the allegations are denied.

19. Construing this paragraph as a statement of allegations made upon information and belief, the allegations are denied.

20. The allegations of this paragraph are denied as stated. Defendant avers that before the institution of the opposition proceedings, Faberge stated in writing its belief that the Chesebrough mark MATCH is confusingly similar to Faberge's mark MACHO. This belief was set forth in a certified letter addressed to the President of Chesebrough.

21. The allegations of paragraph 21 as stated are denied. Defendant avers that in the Trademark Office proceeding subsequently instituted by Faberge, Faberge asserted in its Notice of Opposition initiating the proceeding that the Chesebrough "Match" mark so resembles opposer's mark "Macho" as to be likely when applied to the goods of Chesebrough to cause confusion, mistake and deception.

22. Defendant is without knowledge or information sufficient to form a belief as to the truth of the allegations of this paragraph and leaves plaintiff to such proof thereof as it may be advised.

23. Denied.

24. Denied.

25. Denied.

26. Defendant repeats and re-avers its answers to paragraphs 1-24 as though fully set forth herein.

27. Denied.

28. Defendant repeats and re-avers its answers to paragraphs 1-26 hereof as though fully set forth herein.

29. Defendant repeats and re-avers its answers to paragraphs 1-26 hereof as though fully set forth herein.

30. Admitted.

31. The allegations of paragraph 31 are denied as stated. Defendant avers that Faberge stated in writing its belief that the Chesebrough mark "Match" is confusingly similar to Faberge's mark "Macho". This position was set forth in a certified letter addressed to the President of Chesebrough.

32. The allegations of paragraph 32 are denied as stated. Defendant avers that in the Trademark Office proceeding Faberge asserted that the Chesebrough "Match" mark so resembled the mark "Macho" as to be likely, when applied to the products set forth in the Chesebrough "Match" trademark application, to cause confusion, mistake and deception; Faberge so alleged in its Notice of Opposition initiating the proceeding.

33. Defendant is without knowledge or information sufficient to form a belief as to the truth of the allegations of this paragraph and leaves plaintiff to such proof thereof as it may be advised.

34. Defendant avers that Faberge has not charged that Chesebrough has violated its rights in the trademark "Macho". Defendant is without knowledge or information sufficient to form a belief as to Chesebrough's past use or

continued use of its trademark "Match" and leaves plaintiff to such proof thereof as it may be advised.

35. Denied.

36. Defendant is without knowledge or information sufficient to form a belief as to the use by Chesebrough of its mark "Match", and leaves plaintiff to such proof thereof as it may be advised.

37. Defendant repeats and re-avers its answers to paragraphs 1-36 of the Complaint as though fully set forth herein.

38. Defendant is without knowledge or information sufficient to form a belief as to the use by Chesebrough of its mark "Match", and leaves plaintiff to such proof thereof as it may be advised.

39. Denied.

40. Defendant repeats and re-avers its answers to paragraphs 1-38 hereof as though fully set forth herein.

41. Defendant is without knowledge or information sufficient to form a belief as to the use by Chesebrough of its mark "Match", and leaves plaintiff to such proof thereof as it may be advised.

42. Denied.

43. Defendant repeats and re-avers its answers to paragraphs 1-41 as though fully set forth herein.

44. Denied.

45. Denied.

46. Defendant repeats and re-avers its answers to paragraphs 1-44 hereof as though fully set forth in its answer.

47. Denied.

WHEREFORE, defendant prays that the Complaint be dismissed and for its costs and reasonable attorneys' fees.

FIRST COUNTERCLAIM

On information and belief, based upon plaintiff's allegations in its Complaint, and based upon assertions by plaintiff in the opposition proceeding before the Trademark Trial and Appeal Board, plaintiff has engaged in past and continued use of its trademark "Match". Without waiving its right to reassert its denial of the existence of a justiciable controversy between plaintiff and defendant with respect to the trademarks "Match" and "Macho" owned by them, respectively, and without waiving its right of review of the District Court's denial of defendant's motion to dismiss the complaint herein for want of subject matter jurisdiction, and to prevent possible loss of right for failure to assert what may be held to be a compulsory counterclaim, defendant, with no knowledge of plaintiff's use of its trademark other than from plaintiff's assertion thereof, counterclaims against plaintiff as follows:

48. Defendant, Faberge, Incorporated ["Faberge"] is a Minnesota corporation with its principal place of business in New York.

49. Plaintiff, Chesebrough-Pond's Inc. ["Chesebrough"] is a New York corporation with its principal place of business in Connecticut.

50. This is a civil action for trademark infringement and unfair competition. This Court has jurisdiction over the subject matter under the provisions of 15 U.S.C. § 1121, 28 U.S.C. § 1338(a,b). Plaintiff has submitted to the jurisdiction of this Court by filing the Complaint herein.

51. Defendant is, *inter alia*, manufacturer and distributor of cosmetics and toilet preparations in the United States and worldwide.

52. Defendant is the owner of United States Trademark Registration No. 952,848, issued February 6, 1973, and

presently in full force and effect, for the trademark "Macho" for personal hygiene spray. Defendant's rights in this registration have become incontestible pursuant to 15 U.S.C. § 1065.

53. Commencing as early as 1970, the trademark "Macho" has been used continuously — first by defendant's predecessor and then by defendant — in the sale, offering for sale, distribution and advertising in interstate commerce of a broad line of men's cosmetics and toilet preparations, including personal hygiene spray, cologne, non-aerosol spray cologne, spray deodorant, soap, aftershave conditioner, antiperspirant stick deodorant, friction lotion, skin moisturizer and shave cream.

54. Since 1970, the "Macho" cosmetics and toilet preparations have been marketed — first by defendant's predecessor and then by defendant — through various types of retail outlets, including men's stores, specialty stores and men's departments of department stores.

55. "Macho" cosmetics and toilet preparations have been and are advertised and promoted by defendant in media including national television and publications that advertise and promote products including men's dresswear and sportswear.

56. As the result of the expenditure by defendant of very substantial sums in establishing and maintaining its trademark "Macho" as a symbol of defendant, its quality products and its good will, the trade and purchasing public have come to recognize the trademark "Macho" as distinctive of defendant's products, and as indicating the source of those products. Annual sales of "Macho" products are presently in excess of one million dollars ($1,000,000), and annual advertising of "Macho" products is presently in the amount of many hundreds of thousands of dollars.

57. On information and belief plaintiff has infringed defendant's trademark and said trademark registration for "Macho" by adopting and using the confusingly similar trademark "Match", long subsequent to the adoption of "Macho" by defendant's predecessor, in connection with the sale, offering for sale, distribution and advertising of toiletries in interstate commerce. Plaintiff's continued use of its trademark "Match" is likely to cause confusion, to cause mistake and to deceive in relation to the products bearing defendant's said trademark, and plaintiff will continue so to infringe unless enjoined by this Court.

58. On information and belief plaintiff's aforesaid use of the trademark "Match" is for the unlawful purpose of creating confusion, mistake and deception of the public by appropriating the good will and reputation of defendant and by conveying to the public the false impression that plaintiff's products are sold by, sponsored by, or sold under the auspices of defendant. Such use by plaintiff of the trademark "Match" constitutes unfair competition by plaintiff against defendant.

59. Defendant and its predecessor have continuously, since long prior to the acts herein complained of, used a notice conforming to 15 U.S.C. 1111 in association with its trademark.

WHEREFORE, defendant prays that:

1. Plaintiff, its officers, directors, employees, agents, servants, attorneys and all other persons in consort or privity with plaintiff be preliminarily and permanently enjoined from directly or indirectly using the term "Match" or any other term confusingly similar to "Macho" in connection with the sale, offering for sale, distribution or advertising of plaintiff's products.

2. Plaintiff be ordered to account and pay over to defendant the profits of plaintiff from the infringing and unlawful acts complained of; to account and pay over to defendant all damages to defendant from the infringing and unlawful acts complained of; and to pay over to defendant treble the amount of said damages, reasonable attorneys' fees and the costs of this action.

3. Defendant have such other and further relief as the Court may deem just and proper.

SECOND COUNTERCLAIM

Defendant brings this compulsory counterclaim against plaintiff and alleges as follows:

60. This is an action for malicious prosecution in the wrongful use of administrative and civil proceedings.

61. This compulsory counterclaim falls within the ancillary jurisdiction of the Court. This Court also has jurisdiction over the subject matter under the provisions of 28 U.S.C. § 1338(b). Plaintiff has submitted to the jurisdiction of this Court by filing the Complaint herein.

62. Defendant realleges paragraphs 48 and 49 as though fully set forth herein.

63. Defendant is the owner of the trademark "Macho" for a certain toiletry and of trademark Registration No. 952,848 thereon which defendant on or about June 3, 1975, acquired by assignment from its predecessor, Ralph Lacher and Jordan K. Rand Limited.

64. On or about February 4, 1975, plaintiff filed in the United States Patent and Trademark Office ["Trademark Office"] application Serial No. 43,374 to register "Match" as a trademark for certain toiletries.

65. In the *Official Gazette* of August 5, 1975 of the Trademark Office, notice of application Serial No. 43,374 filed by plaintiff as aforesaid was published for opposition.

66. On or about October 6, 1975, defendant, pursuant to the provisions of 15 U.S.C. §§ 1063, 1067-1069, believing it would be damaged by the registration sought by plaintiff's said application Serial No. 43,374, duly filed a Notice of Opposition praying that the registration sought be not allowed. Opposition No. 57,551 was thereupon duly declared between defendant and plaintiff.

67. On or about January 16, 1976, plaintiff filed its answer to the said Notice of Opposition, petitioning as a counterclaim that defendant's Registration No. 952,848 be canceled on grounds stated therein, of which there were four.

68. The first said ground was that the mark shown in Registration No. 952,848 was allegedly not used prior to the date of first use claim therein. That allegation was made by plaintiff without probable cause to believe that it was true, or, that, if true, it constituted a ground for cancellation of the said registration.

69. The second said ground was that the trademark shown in Registration No. 952,848 was allegedly not used by opposer and/or its predecessor upon the goods described in that registration for a period of at least two consecutive years subsequent to the date of first use claimed in the registration. That allegation was made by plaintiff without probable cause to believe that it was true, or that, if true, it constituted a ground for cancellation of the said registration.

70. The third said ground was that the trademark shown in Registration No. 952,848 allegedly was not used by opposer and/or its predecessor upon the goods described in the registration for a period of at least two consecutive years immediately prior to the filing of plaintiff's petition for cancellation. That allegation was made by plaintiff without

probable cause to believe that it was true or that, if true, it constituted a ground for cancellation of the said registration.

71. By answer to defendant's interrogatories, on September 23, 1976, plaintiff admitted that it had no specific knowledge of any person or other entity, document, etc., relating to or having knowledge of any evidence which had any bearing on the truth or lack of truth of the allegations contained in the second and third of said grounds, the first of said grounds having not been inquired into by defendant because of its obvious immateriality.

72. On October 13, 1977, defendant served, and thereafter filed, a motion for summary judgment on plaintiff's said petition to cancel accompanied by affidavits by one of defendant's officers and by its predecessor offering many dozens of invoices attesting continuous use of the trademark shown in Registration No. 952,848 upon the goods described in that registration throughout the periods of nonuse that had been alleged by plaintiff in the first, second and third grounds as aforesaid.

73. Over the period October 13, 1977 to June 20, 1978, plaintiff, acting in a totally predatory manner with the evident purpose of harrassing defendant with costly and needless discovery, including the filing of burdensome interrogatories, the taking of depositions and the requirement of production of documents, continued in the pursuit of its purported defenses on the said three grounds, well knowing that there was no possible cause to believe they could be established.

74. On June 20, 1978 plaintiff brought a motion in the Opposition for leave to amend its answer by deleting grounds 2 and 3 in their entirety, continuing with its allegations as to ground 1.

75. On November 30, 1978, the Trademark Trial and Appeal Board granted defendant's said motion for summary judgment on plaintiff's counterclaim petition to cancel the said Registration No. 952,848 on the three grounds of non-use as aforesaid.

76. On October 18, 1978 plaintiff filed in the United States District Court for the Central District of California the Complaint in this action against defendant, seeking cancellation of said trademark registration. None of the three grounds of non-use aforesaid is alleged in this action as a basis for seeking cancellation.

WHEREFORE, defendant prays that:

1. Plaintiff be enjoined from continuing to use the judicial system in such a way as to harass defendant and to cause needless hardship and expense to defendant, all without probable cause.

2. Plaintiff be ordered to account and pay over to defendant all damages to defendant from the acts complained of, and to pay over to defendant reasonable attorneys' fees and the costs of this action.

3. Defendant have such other and further relief as the Court may deem just and proper.

Dated: May 18, 1979

Faberge, Incorporated,
Defendant

By /s/ Richard Whiting
Richard Whiting
Its Attorney
Davis Hoxie Faithfull & Hapgood
45 Rockefeller Plaza
New York, New York 10020

Of Counsel:
Wyman, Bautzer, Rothman & Kuchel
2 Century Plaza, 14th Floor
2049 Century Park East
Los Angeles, California 90067
Tel.: (213) 556-8000

Notice of Appeal to the United States Court of Customs and Patent Appeals.

In the United States Patent and Trademark Office.

In the matter of Opposition Faberge, Incorporated, Opposer, v. Chesebrough-Pond's Inc., Applicant, No. 57,551.

Filed: January 26, 1979.

To the Commissioner of Patents and Trademarks:

You are hereby notified that applicant Chesebrough-Pond's Inc. is appealing to the United States Court of Customs and Patent Appeals from the decision of the Trademark Trial and Appeal Board rendered on November 30, 1978 (a) denying applicant's motion for an extension of time for the filing of a response to opposer's renewed motion for summary judgment, (b) granting opposer's renewed motion for summary judgment on applicant's counterclaim for cancellation of Trademark Registration No. 952,848, and (c) dismissing applicant's counterclaim for cancellation of Trademark Registration No. 952,848.

Dated: January 25, 1979

Respectfully submitted,

/s/ John M. Scagnelli

John M. Scagnelli
Attorney for Applicant
Chesebrough-Pond's Inc.
33 Benedict Place
Greenwich, Connecticut 06830
(203) 661-2000

August 25, 1975

Mr. Ralph E. Ward
President
Chesebrough-Pond's
33 Benedict Place
Greenwich, Connecticut 06830

Dear Mr. Ward:

In the August 5, 1975 edition of the U.S. Patent and Trademark Official Gazette, your company's application #43374 for the trademark MATCH was published for opposition purposes.

Faberge, Incorporated is the owner of United States trademark registration #952848 on the trademark MACHO in International Class 3.

It is our belief that your trademark MATCH is confusingly similar with our trademark MACHO. If your application to register the trademark MATCH is not voluntarily withdrawn from the United States Patent and Trademark Office, Faberge, Incorporated will file opposition thereto.

I look forward to hearing from you at your earliest convenience as to what action you intended to take.

Very truly yours,

FABERGE, INCORPORATED

Arlene B. Savitsky
Trademark Counsel

ABS:jp

CERTIFIED MAIL
RETURN RECEIPT REQUESTED

Table 8. — Summary of Contested Trademark Cases. (Within The Patent And Trademark Office.)

Annual Report of the Commissioner of Patent and Trademarks. Fiscal Year 1980.

Trademark Trial And Appeal Board	Ex parte	Cancel	Conc. Use	Inter	Oppos.	Total
Receipts						
Cases Pending as of 9/30/79	229	563	32	0	1,798	2,622
Cases Filed During FY 1979	190	293	12	0	941	1,436
Total Receipts	419	856	44	0	2,739	4,058
Disposals	226	340	20	0	1,174	1,760
Total Cases Pending as of 9/30/79	193	516	24	0	1,565	2,298

Table 20. — Summary of Contested Trademark Cases. (Within the Patent and Trademark Office.)

Annual Report of the Commissioner of Patent and Trademarks.

Fiscal Year 1981.

Trademark Trial and Appeal Board	Ex Parte	Cancel	Conc. Use	Inter	Oppos.	Total
Receipts						
Cases Pending as of 9/30/80	193	516	24	0	1,565	2,298
Cases Filed During FY 1981	240	329	26	1	1,644	2,240
Total Receipts	433	845	50	1	3,209	4,538
Disposals	177	309	20	0	1,088	1,594
Total Cases Pending as of 9/30/81	256	536	30	1	2,121	[1]2,944

[1]Does not include those cases which have been finally decided but which are awaiting the expiration of the appeal period.